

REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

Applicants thank Examiner Hossain for the courtesy extended during a telephonic discussion of the outstanding office action. The remarks below incorporate the substance of this discussion.

Claims 1-3, 5-8, 10, 11, 14, 15, 18 and 20-23¹ were rejected under 35 U.S.C Section 102(b) as allegedly being "anticipated" by Shaffer (EP 0 848 560). For the reasons set forth below, Applicants traverse this rejection.

Claim 1 calls for a communication system that includes an information server and a communication apparatus that includes communication circuitry capable of performing communication with the information server in first and second communication modes *to receive information sent from the information server in response to an information acquisition request generated by the communication apparatus and communicated to the information server via the communication circuitry*. The communication apparatus further includes *an output device for outputting the information received from the information server*. A non-limiting example embodiment of this communication system is shown in Figure 1 in which a communication apparatus 1 communicates with an information server 2. The communication apparatus may, for example, be a mobile terminal. Claim 1 further calls for the communication apparatus to include a connection information storage section and a communication mode switching section for controlling the switching of communication mode with the information server from a first communication mode to a second communication mode.

Shaffer discloses that communication mode switching is performed by equipment disposed between remote sites that are performing communication. As is plainly evident from Figure 2, the manager device of Shaffer is disposed in the communication path between the remote sites 46, 48 and 50. This manager device controls interfaces 44 to connect these remote sites in various communication modes based on quality of service information and on tariff information. Specifically, "[t]he mode select/controller is connected to all of the interface

¹ Claims 15, 18 and 20-23 are not identified in the statement of the rejection on page 2 of the office action. However, the office action treats these claims on pages 8-9 as allegedly being anticipated by Shaffer.

devices 44 and enables the devices on a session-by-session basis to connect various multimedia sites 46, 48 and 50 over the selected communication mode." Shaffer, col. 8, lines 18-22.

Because the remote sites performing communication in Shaffer are not involved in the determination of when (or if) to switch communication modes, there is no disclosure or suggestion in Shaffer, for example, of a communication apparatus as claimed which performs communication with an information server and includes a connection information storage section or a communication mode switching control section.

As discussed with the Examiner, the manager device shown in Figure 2 of Shaffer cannot properly be alleged to correspond to the claimed communication apparatus and claim 1 has been amended to even more clearly emphasize the distinctions therebetween. With reference to the above-italicized claim language, the manager device of Shaffer does not receive information sent from an information server in response to an information acquisition request generated by the manager device. Additionally, the manager device of Shaffer does not include an output device for outputting information received from an information server. For at least these reasons, Shaffer's management device cannot constitute the claimed communication apparatus.

Moreover, Shaffer does not provide details of the remote sites 46, 48 and 50 and there is certainly no disclosure or suggestion that any of these sites includes a communication apparatus as specified in claim 1.

Because of the above-noted deficiencies of Shaffer, Applicants respectfully submit that Shaffer cannot anticipate the subject matter of claim 1.

Independent claims 10, 11 and 15 each call for a communication apparatus with a communication mode switching control section, wherein, among other things, the communication apparatus generates an information acquisition request and communicates the request to an information server and includes an output device for outputting information received from the information server. Shaffer is likewise deficient with respect to these claims for reasons similar to those advanced above with respect to claim 1.

The dependent claims 2, 3, 5-8, 14, 18 and 20-23 are believed to be allowable because of their respective dependencies and because of the additional patentable features recited therein.

Claim 4 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Shaffer in view of Kunz (U.S. Patent No. 6,223,221). Kunz is referenced in the office action as disclosing the measuring of download and connection time to perform a certain task. While not

conceding, among other things, the propriety of the proposed combination, Kunz does not remedy the deficiencies of Shaffer in connection with claim 1 (from which claim 4 depends). As such, even if these documents were combined as proposed, the subject matter of claim 4 would not result.

Claim 9 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Shaffer in view of Watson (U.S. Patent No. 6,631,409). Watson is referenced in the office action as disclosing the overriding default settings. While not conceding, among other things, the propriety of the proposed combination, Watson does not remedy the deficiencies of Shaffer in connection with claim 1 (from which claim 9 depends). As such, even if these documents were combined as proposed, the subject matter of claim 9 would not result.

Claims 12 and 13 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Shaffer in view of Davis (U.S. Patent No. 5,583,922). Davis is referenced in the office action as disclosing switching back to voice mode once data transmission is completed. While not conceding, among other things, the propriety of the proposed combination, Davis does not remedy the deficiencies of Shaffer in connection with claim 1 (from which claims 12 and 13 each depends). As such, even if these documents were combined as proposed, the subject matter of claims 12 and 13 would not result.

Claims 16 and 17 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Shaffer.

Even assuming for the sake of argument that an URL were to be used as connection information, Shaffer is nonetheless deficient with respect with to claim 15, from which claim 16 depends.

With respect to claim 17, Applicant strongly disagrees that it would have been obvious to embody the communication section, the storage section, the output device and the communication mode switching control section in a portable terminal. The system of Shaffer is disclosed as being arranged to establish communication between remote sites and is shown in Figure 2 as being disposed between these remote sites. In view of the nature of the Shaffer system, there is no basis for concluding that the elements of this system would have been provided in a portable terminal. The office action makes reference to the modem of Figure 1 and to a "computer" allegedly shown in Figure 2 in support of the contentions therein, but it is not clear how these two statements are suggestive of a "portable terminal" as claimed.

DEMOTO et al.

Serial No. 09/901,125


Response to Office Action dated March 6, 2006

Claim 19 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Shaffer in view of McLain (U.S. Patent No. 6,493,758). McLain is described in the office action as disclosing the placing of a limit on data to be downloaded from a server, such that if it exceeds a reference value, "discontinuation" will take place. While McLain does describe a user-specified download limit, McLain teaches that exceeding this limit results in not downloading information. There is no disclosure of using such a limit as a basis for switching communications modes because the intent of McLain is to "discontinue" communication, not to provide an alternate mode for doing so. As such, the proposed combination of Shaffer and McLain would not have resulted in the subject matter of claim 19.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 
Michael J. Shea
Reg. No. 34,725

MJS:mjs

901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100